1 Filed

306.35565X00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: REDECKER et al

Serial No.: 08/894,351

Filed: October 27, 1997

For: Gas Producing Mixtures

Art Unit: 3641

Examiner: E.A. Miller

RESPONSE

Mail Stop: Amendment (No Fee)
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 7, 2004

Sir:

This is in response to the Office Action mailed May 5, 2004, in connection with the above-identified application.

In numbered section 1 of the office action, the Examiner alleges that "applicants are required, for applicants response to be complete, and within the time for response to this action, to present a 'listing of claims' in this application, in accordance with new rule, 37 CFR 1.121(c)(3)." While there is no basis either in 37 CFR 1.121(c)(3) or otherwise for the Examiner to require applicants to provide a listing of claims, applicants are voluntarily providing herewith, for the Examiner's convenience, a listing of claims attached hereto as an appendix.

In numbered section 2 of the office action, the Examiner alleges applicants to not fully argue the Examiner's reasons in support of the rejection under 35 USC 103

and the obviousness-type double patenting rejection. This allegation is traversed.

With respect to the rejection under 35 USC 103, the Examiner admits that applicants' arguments regarding improved results are properly made. This argument alone is a sufficient reply to the rejection under 35 USC 103. Whether or not the Examiner agrees with this or the other arguments in the prior response, clearly applicants' reply was fully responsive, at least insofar as it contained valid arguments of unexpected results.

With respect to the obviousness-type double patenting rejection, the Examiner alleges that "[w]hat is 'taught or suggested' is irrelevant to the issue of claim overlap...." Clearly, however, in order to make out a prima facie case of obviousness-type double patenting, the Examiner must show that the differences between the presently claimed invention and the claims of the prior patent would have been obvious to those of ordinary skill in the art. Such an analysis clearly requires an analysis of what is taught or suggested. Applicants' argument that the presently claimed invention is neither taught nor suggested by the claims of the prior art is clearly a proper response to the obviousness-type double patenting rejection.

With respect to both the rejection under 35 USC 103 and the obviousness-type double patenting rejection, the Examiner may or may not be convinced by applicants' arguments made in response to these rejections. Clearly, however, applicants' arguments are responsive to the rejections. Therefore, the Examiner's holding otherwise is improper.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli,

Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 306.35565X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

Alan E. Schiavelli
Registration No. 32,087

AES/jla
(703) 312-6600